

REMARKS

In the office action mailed November 10, 2009, the Examiner rejected pending Claims 1 – 20 under 35 U.S.C. § 102 or 35 U.S.C. § 103 as being anticipated or obvious in view of the Luciano reference (U.S. Patent No. 6,705,944), the Cannon reference (U.S. Patent No. 6,652,378) or some combination thereof. By this paper, the Applicant has amended Claim 1 to highlight the subject matter that the Applicant believes is allowable over the art of record. Hence, reconsideration of the above-captioned application in light of the amendments and remarks contained herein is now respectfully requested.

After carefully reviewing Luciano, the Applicant notes that Luciano does not disclose a gaming system wherein the base game and the second game are initiated substantially simultaneously as is now required by Claim 1 as amended. Luciano only discloses embodiments of the game where each of the embodiments contemplates that the wheel game is only activated after the conclusion of the reel game.

More specifically, Luciano notes that “The present invention apparatus includes at least two games of chance, the first game of chance provides a first game outcome, including the possibility to activate the second of change *upon the occurrence of one or more predetermined outcomes* in the first game of chance.” (See, Luciano Col. 2 line 54 – 58). Luciano further discloses that the decision of whether the wheel game is even initiated is dependent upon the outcome of the reel game.

Further, the flowchart of Figure 8 and the associated description in Col. 8, and Col. 9 of Luciano, clearly illustrate that the initiation of the wheel game is dependent upon the results, *i.e.*, the completion, of the first game. For example, in Col. 8, Luciano describes that the wheel game is activated when the reel game stops while displaying the “spin wheels” symbol. As such, Luciano cannot be said to anticipate under 35 U.S.C. § 102 or render obvious under 35 U.S.C. § 103 Claim 1 as amended.

In the office action, the Examiner cited Cannon as disclosing the concept of simultaneously playing multiple games and argued that it would have been obvious to modify Luciano with the teachings of Cannon. However, the Applicant notes that such a modification of Luciano would both render Luciano unsatisfactory for its intended purpose and change the

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principle of operation and, thus, is an improper combination (*See*, Manual of Patent Examining Procedure §§ 2143.02 (V) and (IV)).

More specifically, the very purpose of Luciano adding the second game is to prolong the playing experience to thereby enhance the excitement of the game. Luciano seeks to further enhance the excitement by having the second game outcome affect the first game outcome, either the concluded first game or future first games. Necessarily, Luciano requires that the first game be concluded before the second game is initiated. Indeed, as discussed above, the second game is only initiated based upon the outcome of the first game. The second game is not automatically initiated; the correct game result, *e.g.*, the appearance of the “spin wheels” symbol in the first game must occur to initiate the second game. Thus, both the principle of operation and intended purpose of the Luciano game is to initiate the second game by the results of the first.

The modification proposed by the Examiner would fundamentally change the manner of operation of Luciano. The outcome of the first game cannot be used to initiate the second game if they are played simultaneously. Thus, the proposed combination would require a substantial reconstruction and redesign of the Luciano game to come up with some way of initiating the second game that is not based upon the outcome of the first game. The Applicant notes that suggested combinations of references that require substantial reconstruction and redesign of the elements shown in the primary reference as well as a change in the basic principle of operation under which the primary reference is designed to operate is an impermissible combination for obviousness reasons (*See*, MPEP § 2143.02 (VI) citing *In re Ratti*, 123 U.S.P.Q. 349 (CCPA 1959)).

The Applicant therefore submits that the proposed combination of Luciano and Cannon is not permissible and, as such, Claim 1 is allowable over the art of record. The Applicant further submits that Claim 20 is also allowable for reasons similar to the reasons given above. The Applicant further submits that the remaining claims define additional patentable subject matter and are further allowable due to their respective dependencies on Claims 1 and 20.

Hence, the Applicant believes that the above-captioned application is in condition for allowance and requests the prompt allowance of the same. Should there be any impediment to the prompt allowance of this application that could be resolved by a telephone conference, the Examiner is respectfully requested to call the undersigned at the number shown below.

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No Disclaimers or Disavowals

Although the present communication may include alterations to the application or claims, or characterizations of claim scope or referenced art, Applicant is not conceding in this application that previously pending claims are not patentable over the cited references. Rather, any alterations or characterizations are being made to facilitate expeditious prosecution of this application. Applicant reserves the right to pursue at a later date any previously pending or other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or by any prior prosecution. Accordingly, reviewers of this or any parent, child or related prosecution history shall not reasonably infer that Applicant has made any disclaimers or disavowals of any subject matter supported by the present application.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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Dated: May 10, 2010

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